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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,389	09/28/2001	Mark Kirkpatrick	BS01-290	2348

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EXAMINER

ENG, GEORGE

ART UNIT PAPER NUMBER

2643

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,389

Applicant(s)

KIRKPATRICK, MARK

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/4/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 1/4/2005 has been considered.

Response to Preliminary Amendment

2. This Office action is in response to the preliminary amendment filed 1/4/2005.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/964,385 and claims 1-20 of copending Application No. 10/101,630. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed limitations, i.e., a battery and a sound generating device, are

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transparently found in the copending Application No. 09/964,385 and copending Application No. 10/101,630 with obvious wording variations. See the following example of claim 1 of present application, copending Application No. 09/964,385 and copending Application No. 10/101,630.

Application 09/964,389	Application 09/964,385	Application 10/101,630
A device that plays alerts and is used with a wireless communications device,	A battery assembly system for a cellular telephone,	A battery assembly system for a cellular telephone,
a substantially rectangular planer shell having electrical terminals on one side that are electrically connectable to electrical terminal on the wireless communication device,	a first battery for providing power to the cellular telephone,	a first battery for providing power to the cellular telephone,
an alert generating device located inside the shell and electrically connected to the electrical connectors of the planner shell, comprising a memory for storing an alert file, wherein the alert generating device is triggered to play an alert associated with the alert file upon detection of an incoming communication by the wireless communication device.	a first sound generating device attached to the first battery and comprising a memory for storing a first sound file, wherein the first sound generating device is triggered to play sound associated with the first sound file when the first battery is installed in the cellular telephone upon detection of a telephone call by the cellular telephone.	a first sound generating device attached to the first battery and comprising a memory for storing a first sound file downloaded from a removable memory device attachable to the first battery, wherein the first sound generating device is triggered to play sound associated with the first sound file when the first battery is installed in the cellular telephone upon detection of a telephone call by the cellular telephone.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

5. Claims 1, 6, 18, 20, 21 and 25 are objected to because of the following informalities: claim 1, lines 4-5, "a wireless communications device" should be --the wireless communication device--; claim 6, line 4, "a wireless communications device" should be --the wireless communication device--; claim 18, lines 3-4, "a wireless communications device" should be --the wireless communication device--; claim 20, lines 3-4, "a wireless communications device" should be --the wireless communication device--; claim 21, line 2, "the cellular telephone" should be --a cellular telephone-- and claim 25, line 4, "a wireless communications device" should be --the wireless communication device-- to be corrected. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5-10, 12-14, 16-19 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Stone et al. (US PAT. 5,767,778 hereinafter Stone).

Regarding claim 1, Stone discloses a device (31, figure 4) that plays alerts and is used with a wireless communications device (32, figure 4), the device comprising: a substantially rectangular planar shell having electrical terminals (14b and 15c, figure 3) on one side that are

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electrically connectable to electrical terminals (14a and 15a, figure 3) on a wireless communications device, and an alert generating device (38, figure 4) located inside the shell and electrically connected to the electrical connectors of the planar shell, comprising memory (42, figure 42) for storing an alert file, wherein the alert generating device is triggered to play an alert associated with the alert file upon detection of incoming communication by the wireless communications device (col. 4 line 13 through col. 5 line 35 and col. 7 lines 10-31).

Regarding claim 2, Stone discloses the alert generating device being a sound generating device (col. 7 lines 13-14), wherein the alert file is a sound file and the alert is an audio alert (col. 7 lines 26-28), and wherein the sound generating device stores a plurality of sound files, and wherein each sound file can be designated as an audio alert signal for the telephone (col. 7 lines 28-31).

Regarding claim 3, Stone teaches an external connector socket in electrical communication to provide external access to the plurality of sound files in the sound generating device (col. 7 lines 21-23).

Regarding claim 5, Stone discloses a device (31, figure 4) for a wireless communication device (32, figure 4) that plays alerts, the device comprising a shell (13, figure 3) attachable between a wireless communications device body (11, figure 3) and a wireless communications device battery (12, figure 3), an alert generating device (38, figure 4) inside the shell and comprising memory (42, figure 40) for storing a plurality of alert files, wherein the alert generating device is triggered to play an alert associated with the alert file upon detection of incoming communication by the wireless communications device, an external connector socket (43, figure 4) on the shell in electrical communication with the alert generating device to provide

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external access to the plurality of alert files in the alert generating device and a selector, i.e., a mode switch, on the shell for designating a file to use as an audio alert (col. 4 line 13 through col. 5 line 35 and col. 7 lines 10-31).

Regarding claim 6, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 7, Stone discloses a wireless communications device system having changeable alert signals, the system comprising a wireless communications device body (11, figure 3) a wireless communications device battery (12, figure 3) for powering the wireless communications device body; and an alert signal device (31, figure 4) connectable with the wireless communications device body and the wireless communications device battery, including an alert generating device (38, figure 4) comprising memory (42, figure 4) for storing an alert file, wherein the alert generating device is triggered to play an alert associated with the alert file upon detection of incoming communication by the wireless communications device (col. 4 line 13 through col. 5 line 35 and col. 7 lines 10-31).

Regarding claim 8, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claims 9-10, Stone teaches an external connector socket (43, figure 4) in electrical communication to provide external access to the plurality of sound files in the sound generating device such that a computer system includes an electrical plug connected to the sound generating device through the connector socket for editing the plurality of sound files by adding or deleting from the sound generating device (col. 7 lines 16-23).

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Regarding claim 12, Stone teaches the alert generating device being a sound generating device (col. 7 lines 13-14), wherein the alert file is a sound file and the alert is an audio alert (col. 7 lines 26-28), and wherein the sound generating device stores a plurality of sound files that are capable of being edit (col. 7 lines 18-23).

Regarding claims 13-14, the limitations of the claims are rejected as the same reasons set forth in claims 9-10.

Regarding claims 16 and 17, Stone discloses the system comprising an external connector, i.e., accessing means (43, figure 4), on the audio signal device in electrical communication with the sound generating device to provide external access to the plurality of sound files in the sound generating device, a computer system, i.e., programming means, having an electrical plug electrically connected to the sound generating device through the connector socket, for editing the plurality of sound files by adding or deleting from the sound generating device, and a selector device, i.e., selecting means (41, figure 4) on the audio signal device for designating a sound file to use as an audio alert signal (col. 5 lines 10-25 and col.7 lines 10-31).

Regarding claim 18, Stone discloses a method of programming designating alert signals on a wireless communication device comprising the steps of providing an alert signal device (31, figure 4) for use with a wireless communications device (32, figure 4), the alert signal device including a programmable alert generating device (38, figure 4) and an external socket (43, figure 4) located on an outside surface, connecting a computer system containing software that can access the alert generating device to the external socket of the audio alert signal device, accessing the alert generating device, adding or deleting an alert file via the computer onto or

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from the alert generating device, respectively (col. 4 line 13 through col. 5 line 35 and col. 7 lines 10-31).

Regarding claim 19, Stone teaches that the computer system is a PC, which is inherently including a personal data assistant (col. 7 lines 21-23).

Regarding claim 21, Stone discloses a computer readable medium containing instructions that when executed by a processor of a wireless device perform acts, wherein the cellular telephone includes a cellular telephone body (32, figure 4), a cellular telephone battery (30, figure 4) for powering the cellular telephone body, an audio signal device (31, figure 4) connectable with the cellular telephone body and the cellular telephone battery, including a sound generating device (38, figure 4), memory (42, figure 4), and a selector device (41, figure 4), comprising the acts of storing a plurality of sound files in memory, receiving input from the selector device, designating a file of the plurality to use as an alert signal and alerting a user with the alert signal of the designated file in response to an incoming communication (abstract and col. 4 line 13 through col. 5 line 35 and col. 7 lines 10-31).

Regarding claims 22-24, Stone discloses that the wireless device is a cellular telephone (32, figure 4), the alert is a sound (col. 7 lines 13-14) and the incoming communication is a telephone call (col. 2 lines 9-23).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 11, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone (US PAT. 5,767,778 hereinafter Stone) in view of Haraguchi (US PAT. 6,597,279).

Regarding claim 4, Stone teaches a selector device on the shell for selecting plurality of sound files and designating a sound file to use as an alert signal (col. 5 lines 10-25 and col. 7 lines 16-20). Stone differs from the claimed invention in not specifically teaching a user interface for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal. However, Haraguchi teaches a simplified method for setting an incoming tone to be output from a speaker when a signal is received by an operation comprising a jog dial for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal (col. 5 lines 16 through col. 6 line 34) in order to simplify the operation of setting the incoming tone. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Stone in having the user interface for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal, as per teaching of Haraguchi, because it makes user friendly by simplifying the operation of setting the incoming tone.

Regarding claims 11 and 15, the limitations of the claims are rejected as the same reasons set forth in claim 4.

Regarding claim 20, Stone discloses a method of selecting a designating alert signals on a wireless communication device (32, figure 4) comprising the steps of providing an alert signal device (31, figure 4) for use with a wireless communications device (32, figure 4), the alert signal device including a programmable alert generating device (38, figure 4) and a selector (41,

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figure 4) located on an outside surface, wherein the alert generating device includes a plurality of alert files, and selecting a selected alert from the plurality of alert files when a designated alert file is reached (col. 4 line 13 through col. 5 line 35 and col. 7 lines 10-31). Stone differs from the claimed invention in not specifically teaching the step of scrolling through the plurality of sound files with the selector to experience the plurality of alert file. However, Haraguchi teaches a simplified method for setting an incoming tone to be output from a speaker when a signal is received by an operation comprising a jog dial for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal (col. 5 lines 16 through col. 6 line 34) in order to simplify the operation of setting the incoming tone. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Stone in scrolling through the plurality of sound files with the selector to experience the plurality of alert file, as per teaching of Haraguchi, because it makes user friendly by simplifying the operation of setting the incoming tone.

10. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone (US PAT. 5,767,778 hereinafter Stone) in view of Sawada et al. (US PAT. 6,810,274 hereinafter Sawada).

Regarding claim 25, Stone discloses a device (13, figure 3) that plays alerts and is used with a wireless communications device (11, figure 3), the device comprising a planar shell having electrical terminals (14b and 15b, figure 3) on one side that are electrically connectable to electrical terminals (14a and 15a, figure 3) on a wireless communications device, and an alert generating device (38,, figure 4), located inside the shell and electrically connected to the

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electrical connectors of the planar shell, comprising memory (42, figure 4) for storing an alert file, wherein the alert generating device is triggered to play an alert associated with the alert file upon detection of an incoming communication by the wireless communications device. Stone differs from the claimed invention in not specifically teaching the alert generating device comprising a memory receiving slot for adding new alert signal from a second memory positioned within the memory receive slot. However, Sawada teaches a battery pack (2, figure 1) supplying the portable telephone unit (1, figure 1) with electrical power having a removable IC card having semiconductor memory (3, figure 1) and an audio device (38, figure 8) having a memory receiving slot (5, figure 2) for adding new alert signals from a second memory positioned within the memory receiving slot (col. 3 lines 16-24 and col. 4 line 60 through col. 5 line 10) in order to reduce size. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Stone in having the alert generating device further comprising the memory receiving slot for adding new alert signal from a second memory positioned within the memory receive slot, as per teaching of Sawada, because it reduces size of the device.

Regarding claim 26, Stone discloses that the wireless device is a cellular telephone (32, figure 4), the alert is a sound (col.7 lines 13-14) and the incoming communication is a telephone call (col. 2 lines 9-23).

Regarding claim 27, the limitations of the claim are rejected as the same reasons as set forth in claim 25.

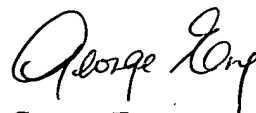
Regarding claim 28, the limitations of the claim are rejected as the same reasons as set forth in claim 26.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tue-Fri 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



George Eng
Primary Examiner
Art Unit 2643